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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/338,185 06/22/99 ZABLOCKI

J 99.423

020306 HM22/0313  
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EXAMINER

CRANE, J

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

03/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/338,185

Applicant(s)

Zablocki et al.

Examiner

L. E. Crane

Group Art Unit

1623

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on 05/09/00 (IDS)

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above claim(s) is/are withdrawn from consideration.

☐ Claim(s) is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) is/are objected to.

☐ Claim(s) are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

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The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1600, Art Unit 1623.

- 5        No claims have been cancelled and no preliminary amendments filed as of the date of the instant Office action. An Information Disclosure Statement (IDS) filed May 9, 2000 has been received and entered into the case.

Claims 1-25 remain in the case.

- 10        Claims 1-25 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- 15        Claim 1 is directed broadly to a vast array of compounds with multiple substituents nested on substituents only a small fraction of which have been synthesized or shown by applicant to have pharmacological activity. See also claim 19, last line wherein the term "mixtures thereof" is directed to subject matter not enabled by
- 20        any examples found in the instant disclosure. Applicant is respectfully requested to limit the instant claims to subject matter properly enabled by the instant specific embodiments.

Claims 1-25 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention.

In claims 1-23 reference to the subject matter of claim 1 as a "composition" or a "composition of matter" is technically incorrect.

5 Applicant is respectfully requested to substituted to term "compound."

In claim 1 at line 3, the term " $R_1 = CH_2OH, -CONR_5R_6$ ;" is grammatically incorrect. Did applicant intend the term to read --  $R_1 = \underline{-CH_2OH}$ , or  $-CONR_5R_6$ ; --?

10 In claim 1 at line 18, the term "alkyl or aryl or heteroaryl amide" appears to be incomplete and grammatically incorrect. Did applicant intend the term to read

-- alkyl or aryl or heteroaryl carboxamido -- or

-- alkyl or aryl or heteroaryl sulfonamido -- ? This error reoccurs in claims 1 three times.

15 In claim 1 at line 38 the term "wherein optional" is incomplete. Did applicant intend the term to read -- wherein an optional --?

20 Markush and "or" errors occur in claim 1 at lines 3, 19, 20, 29, 53, and 57; in claim 2 at lines 7, 15; in claim 3 at lines 6, 7 and 12; in claim 4 at lines 5, 8 and 10; in claim 5 at lines 5, 10, 11 and 12; in claim 6 at lines 7, 8, 9 and 10; in claim 7 at lines 6, 9 and 10; in claim 7 at lines 3, 6, 7 and 8; in claim 8 at lines 6, 7 and 8; in claim 9 at lines 3, 6 and 8; in claim 10 at lines 3, 4 and 6; in claim 13 at lines 8, 10 and 11; in claim 14 at lines 2, 7, 8 9 and 10; in claim 15 at lines 6, 7 and 8; in claim 16 at lines 3, 5 and 7; in  
25 claim 17 at lines 3, 4 and 6; and in claim 19 at line 1.

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In claim 20 at line 1, the term "vasodilatation" is technically incorrect. Did applicant intend the term to read -- vasodilation --.

In claims 23-25 reference to the subject matter being claimed as a "pharmaceutical composition of matter" is technically incorrect.  
5 Applicant is respectfully requested to substituted to term "pharmaceutical composition."

35 U.S.C. §101 reads as follows:

10 "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title."

15 Claim 25 is rejected under 35 U.S.C. §101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. §101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. ,1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149, 149 USPQ 475 (D.D.C. 1966).

Applicant is referred to the term "useful" at line 2 of claim 25.

20 A review of the art supplied by applicant and the closest prior art available in the appropriate US patent class/subclass has not produced any art usable in an art rejection to date.

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Therefore, claims **1-24** would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. §112 set forth in this Office Action.

5 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. §1.56 to point out the inventor and  
10 invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §§102(f) or (g) prior art under 35 U.S.C. §103(a).

15 Papers related to this application may be submitted to Group 1600 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone numbers for the FAX machines operated by Group 1600 are **(703) 308-4556** and **703-305-3592**.

20 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is **703-308-4639**. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Gary Geist, can be reached at (703)-308-1701.

5 Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is 703-308-1235 .

LECrane:lec  
03/12/01

L. Eric Crane  
Patent Examiner  
Group 1600